

US Serial No. 09/986,515
S10007-3-DIV

REMARKS

Claims 1-13 and 33-40 are pending. Independent Claim 1 and dependent Claims 3, 4 and 6 have been amended. Claims 33-40 are newly added. Claims 14-32 have been cancelled.

Through the instant amendment, applicants have made a bona fide effort to place this case in condition for immediate allowance. Reconsideration and allowance of this application in light of the above amendments and the following remarks are respectfully requested.

Restriction Requirement

Restriction to one of three inventions has been required under 35 USC 121; namely, Claims 1-13 (Group I), Claims 14-24 (Group II) and Claims 25-32 (Group III). Within Group I, the examiner requires an election between the species of Claim 3 and Claim 4, and within these species an election of the sub-species of Claims 6, 7, 8 and 9 is required.

Applicants hereby confirm their election to prosecute, with traverse, the subject matter of Group I, Claims 1-13, the species of Claim 3, and the sub-species of Claim 6.

Non-elected Claims 14-32 have been cancelled.

Applicants respectfully request reconsideration of the Examiner's withdrawal of non-elected species and sub-species Claims 4 and 7-9. Insofar as amended Claim 1 is deemed to be allowable, it is submitted that Claims 4 and 7-9 are likewise believed to define allowable subject matter.

Claim Rejections

Claim 5 has been rejected under the second paragraph of 35 USC 112 as being indefinite. It is believed the Examiner meant Claim 3, not Claim 5, since Claim 3 recites the limitation "formula (I)" which does not have antecedent basis in Claim 1. Appropriate

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correction to Claim 3 has been made. Applicants have also made a similar correction to dependent Claim 4. No new matter has been added.

Claims 1-3, 5, 6 and 10 have been rejected under 35 USC 102(b) as being anticipated by Bambury et al., U.S. Patent No. 5,070,215 ("Bambury"). Bambury, col. 16, lines 57-61 is cited as allegedly teaching a blocked mercaptosilane according to formula (1), where p=0, j=1, k=1, the first G=C₂H₃, Y is -OC(=O)-, the second G is propyl, X is (SiR₂)(OSiR₃) and t=0.

Claims 1 and 6 herein have been amended to remove the recitation of Y is -OC(=O)-. Applicants respectfully submit the rejection of Claims 1-3, 5, 6 and 10 over Bambury is now moot; withdrawal of same being earnestly solicited. New Claims 33-40 define a blocked mercaptosilane wherein Y is -OC(=O)-, but where X is not (SiR₂)(OSiR₃). Bambury does not disclose such a silane; Claims 33-40 are therefore deemed to be patentable in view thereof.

Double Patenting Rejections

Claims 1-3, 5, 6, and 10-12 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 and 17-21 of copending Application No. 09/986,511.

Applicants submit herewith a terminal disclaimer under 37 CFR 1.321(b) and (c) to obviate the aforementioned provisional double patenting rejection. Accordingly, it is requested that the instant provisional double patenting rejection be withdrawn.

Claims 1-24 and 33-38 have been rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 2-4 of U.S. Patent No. 6,127,468 or Claims 2, 3, 6, 9, 15 and 19 of U.S. Patent No. 6,204,339.

It is believed the indication of Claims 1-24 and 33-38 being rejected may have been in error. Applicants assume the Examiner intended to reject Claims 1-3, 5, 6, and 10-12. Confirmation on the record is respectfully requested.

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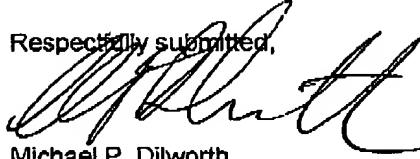
In traverse of these double patenting rejections, applicants submit herewith terminal disclaimers under 37 CFR 1.321(b) and (c). Withdrawal of the aforementioned double patenting rejections is respectfully requested.

Claims 1-13 and 33-40 are now believed to be in condition for immediate allowance, such favorable action being respectfully requested.

Changes to the claims are explicitly shown on the attached pages captioned "Version to Show Changes Made With Markings Showing Same."

Any matters which the examiner believes may be resolved by telephone may be directed to the undersigned.

Respectfully submitted,


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VERSION TO SHOW CHANGES MADE WITH MARKINGS SHOWING SAME

1. (Amended) A blocked mercaptosilane selected from the group consisting of:

$[(ROC(=O))_p-(G)]_k-Y-S]_l-G-(SiX_3)_n$ (1); and

$[(X_3Si)_q-G]_s-[Y-[S-G-SiX_3]_b]_c$ (2)

wherein

Y is a polyvalent species $(Q)_zA(=E)$ selected from the group consisting of $-C(=NR)-$; $-SC(=NR)-$; $-SC(=O)-$; $[-OC(=O)-]$; $-S(=O)-$; $-S(=O)_2-$; $-OS(=O)_2-$; $(-NR)S(=O)_2-$; $-SS(=O)-$; $-OS(=O)-$; $(-NR)S(=O)-$; $-SS(=O)_2-$; $(-S)_2P(=O)-$; $-(\sim S)P(=O)-$; $-P(=O)(-)_2$; $(-S)_2P(=S)-$; $-(\sim S)P(=S)-$; $-P(=S)(-)_2$; $(-NR)_2P(=O)-$; $(-NR)(\sim S)P(=O)-$; $(-O)(-NR)P(=O)-$; $(-O)(\sim S)P(=O)-$; $(-O)_2P(=O)-$; $-(\sim O)P(=O)-$; $-(\sim NR)P(=O)-$; $(-NR)_2P(=S)-$; $(-NR)(\sim S)P(=S)-$; $(-O)(-NR)P(=S)-$; $(-O)(\sim S)P(=S)-$; $(-O)_2P(=S)-$; $-(\sim O)P(=S)-$; and $-(\sim NR)P(=S)-$; wherein the atom A attached to unsaturated heteroatom E is attached to the sulfur which in turn is linked via a group G to the silicon atom;

each R is chosen independently from hydrogen, straight, cyclic, or branched alkyl that may or may not contain unsaturation, alkenyl groups, aryl groups, and aralkyl groups, with each R containing from 1 to 18 carbon atoms;

each G is independently a monovalent or polyvalent group derived by substitution of alkyl, alkenyl, aryl, or aralkyl, wherein G can contain from 1 to 18 carbon atoms, and if G is univalent, G can be a hydrogen atom;

X is independently selected from the group consisting of -Cl, -Br, RO-, RC(=O)O-, $R_2C=NO-$, R_2NO- , R_2N- , -R, and $-(OSiR_2)_l(OSiR_3)$ wherein each R is as above and at least one X is not -R;

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p is 0 to 5; r is 1 to 3; z is 0 to 2; q is 0 to 6; a is 0 to 7; b is 1 to 3; j is 0 to 1, but it may be 0 only if p is 1; c is 1 to 6; t is 0 to 5; s is 1 to 3; k is 1 to 2; with the provisos that (I) if A is carbon, sulfur or sulfonyl, then (i) a + b is 2 and (ii) k is 1; (II) if A is phosphorus, then a + b is 3 unless both (i) c is greater than 1 and (ii) b is 1, in which case a is c + 1; and (III) if A is phosphorus, then k is 2.

3. (Amended) A blocked mercaptosilane according to claim 1 according to formula [(I)] (1).

4. (Amended) A blocked mercaptosilane according to claim 1 according [for] to formula [(II)] (2).

6. (Amended) A blocked mercaptosilane according to claim 1 wherein Y is selected from the group consisting of: [-OC(=O)-]; -SC(=O)-; -S(=O)-; -OS(=O)-; -(-S)P(=O)-; and -P(=O)(-)2.